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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,457	12/27/2001	Dennis E. Smith	82987AEK	8364

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/01/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

CLD 10

Advisory Action

Application No.

10/033,457

Applicant(s)

SMITH ET AL.

Examiner

Walter B Aughenbaugh

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--Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 06 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 6,7 and 24-27.

Claim(s) rejected: 1,2,5-19,21,22,28-40,42 and 43.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION***Acknowledgement of Applicant's Amendments***

1. The amendments made to the specification and to claims 7, 19, 24 and 26 and the cancellation of claim 6 in Applicant's After Final Amendment filed November 6, 2003 (Paper 8) have not been entered due to the fact that they raise new issues that would require further consideration and/or search; e.g. the insertion of "further" between "monomers" and "comprise" in claim 19 requires further consideration and/or search. The word "further" in claim 19 should have been underlined on page 5 of Paper 8 for proper identification of the amendment to claim 19 (the word "further" was inserted in claim 19 in Paper 8). Since paragraph 17 of Paper 6 states that Maier et al. teach that methyl methacrylate is a typical monomer for making the microbeads, in the case where methyl methacrylate is the monomer claimed in claim 1, the "monomers" of claim 1 cannot "further comprise methylnmethacrylate" as claimed in claim 19 since the monomers of claim 1 themselves comprise methylnmethacrylate. A new 35 U.S.C. 112, second paragraph rejection of claim 19 and an objection to claim 19 for failing to further limit a parent claim would also be necessitated for this same reason: since methylnmethacrylate monomers fall within the scope of claim 1, how can the methylnmethacrylate monomers "further comprise methylnmethacrylate" as claimed in claim 19?

ANSWERS TO APPLICANTS ARGUMENTS

2. Applicant's arguments in regard to the 35 U.S.C. 102(b) rejection of claims 1, 2, 5-7, 9-16, 21, 22, 28-35 and 39 as anticipated by Maier et al. have been fully considered but are not persuasive.

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Applicant argues that “There is no teaching of how to choose one or more monomers to form a microbead with a specific thermal stability...” on page 9 of Paper 8, but the claim language “wherein the monomers from which the second polymer is derived are selected to provide microbeads that are thermally stable” is a method recitation that has not been given patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. Applicant argues that “Maier et al. does not even address thermal stability of the microbeads”, but Examiner repeats the position established in paragraph 17 of Paper 6 that

Maier et al. teach the shaped article comprising the microbeads as claimed by Applicant having the same composition as claimed by Applicant, and therefore, the microbeads of Maier et al. are necessarily thermally stable where thermally stable means that the temperature at which the microbeads experience a 2% weight loss is above 270°C, in the absence of objective and convincing evidence to the contrary.

Applicant also argues that “Maier et al. also does not recognize the problem of yellowness in the microbeads”, but this is an irrelevant argument since a limitation specifically reciting “yellowness” is not included in any of the instant claims; the term “low-yellowing” was removed from claim 1 in Paper 5 to obviate the 35 U.S.C. 112, second paragraph rejection of claim 1 made of record in paragraph 9 of Paper 3.

3. In regard to Applicant’s arguments pertaining to the amount of crosslinker (as claimed in claims 18, 37 and 43, and not in any of the claims rejected under 35 U.S.C. 102(b) as Applicant’s placement of these arguments in Paper 8 would suggest) on pages 9-10 of Paper 8, Applicant contradicts Applicant’s own assertion that “Maier et al. does not disclose an amount of crosslinker to be used in forming the microbeads” in the sentence immediately after this assertion that states “The examples of Maier et al. demonstrate an amount of 5% or 30% crosslinker”. This assertion is plainly incorrect. Examiner requests explanation as to how “the formulations

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containing methylmethacrylate monomer and 5% of divinylbenzene as a crosslinker, according to the Office Action, are deemed to fall within Applicants' claims" as Applicant states: the pertinent claims are not rejected under 35 U.S.C. 102.

Applicant argues that "decreasing amounts of crosslinker provide reduced thermal stability" and provides support in the specification and in one of the inventor's declaration (Paper 9). Applicant refers to the data provided in the declaration (the first two lines of which are taken from the specification of the instant application and the third line of which is speculatively extrapolated data as discussed on page 2 of the declaration) that shows that a divinylbenzene crosslinker amount of 5% in a divinylbenzene/methyl methacrylate mixture results in a 2% loss temp that is 10°C lower than the claimed minimum of 270°C. However, the Office Action (Paper 6) does not contend that a divinylbenzene crosslinker amount of 5% reads on the claims 18, 37 or 43, so this point is irrelevant as the relevant claims stand rejected.

Applicant's argument that "it is difficult to predict what amount of a specific crosslinking monomer will produce a desired thermal stability" is irrelevant because no claim in the instant application definitively claims a specific crosslinking agent and because the (asserted) condition that "it is difficult to predict what amount of a specific crosslinking monomer will produce a desired thermal stability" does not mean that the amount of a specific crosslinking monomer that produces a desired thermal stability would not be determined (not predicted, but determined) by one of ordinary skill in the art via routine experimentation. Applicant argues more in regard to "yellowness", but as stated above, any arguments based on yellowness are irrelevant because a limitation specifically reciting "yellowness" is not included in any of the instant claims.

Applicant rehashes the argument that "Maier et al. does not even address thermal stability of the

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microbeads”, but Applicant does, but Examiner repeats the position established in paragraph 17 of Paper 6 in regard to thermal stability. Applicant’s repeated argument regarding the “selection of microbeads” is also irrelevant because the method of forming the article is not germane to the issue of patentability of the article itself.

In response to Applicant’s argument that “Maier et al. does not teach the selection of acrylic or allylic crosslinking monomers”, the limitations on which the Applicant relies (i.e. acrylic or allylic crosslinking monomers) are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

4. Applicant’s arguments in regard to the 35 U.S.C. 103 rejections have been fully considered but are not persuasive.

Applicant generally argues that “thermal stability can not successfully be achieved by routine experimentation without undo trial and error”. Applicant has not specifically addressed the specifics of the 35 U.S.C. 103 rejection of claims 18, 19, 37 and 38 made of record in paragraph 18 of Paper 6, and therefore Applicant’s argument that “thermal stability can not successfully be achieved by routine experimentation without undo trial and error” is unsupported. Furthermore, experimentation, by definition, involves trial and error, and Applicant has not explained how the particular trial and error required in the instant case would be “undo” (presumably, “undue”).

The remainder of Applicant’s arguments made on page 11 of Paper 8 in regard to the 35 U.S.C. 103 rejections were made under the “Rejection of claims 1, 2, 5-7, 9-16, 21, 22, 28-35

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and 39 under 35 U.S.C. 102(b)” heading on pages 9-10 of Paper 8 and have been addressed above.

5. Applicant asserts a showing of unexpected results, but Applicant has not met the burden on Applicant to establish that these results are unexpected and significant in that the evidence relied upon does not establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance” *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) because the claimed invention has not been compared with the closest prior art which is commensurate in scope with the claims as required by MPEP 716.02(b); Dennis E. Smith states on page 2 of his Declaration that “The thermal stability for a 5% crosslink monomer, per the examples of Maier, has not been measured”. As stated above, the first two lines of the table provided in the declaration are taken from the specification of the instant application and the third line of the table is speculatively extrapolated data as indicated on page 2 of the declaration. Any validity of the third line of this table and of the explained reasoning behind making the extrapolation is destroyed by Applicant’s own statement that “it is difficult to predict what amount of a specific crosslinking monomer will produce a desired thermal stability” (page 10 of Paper 6).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
11/26/03

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/26/03